

ESTTA Tracking number: **ESTTA471096**

Filing date: **05/07/2012**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

### Petitioner Information

Name	Matchstic, LLC		
Entity	Limited Liability Company	Citizenship	Georgia
Address	437 Memorial Dr SE Unit A7 Atlanta, GA 30312 UNITED STATES		

Attorney information	Brad C. Parrott Foltz Martin, LLC 3525 Piedmont Rd NE Bldg 5, Ste 750 Atlanta, GA 30305 UNITED STATES BParrott@foltzmartin.com Phone:404-231-9397
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### Registration Subject to Cancellation

Registration No	3972323	Registration date	06/07/2011
Registrant	Parry, Linda S 119 Rockland Center Suite 205 Nanuet, NY 10954 UNITED STATES		

### Goods/Services Subject to Cancellation

Class 035. First Use: 2008/07/15 First Use In Commerce: 2008/07/15 All goods and services in the class are cancelled, namely: Advertising and marketing services, namely, promoting the goods and services of others
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### Grounds for Cancellation

Abandonment	Trademark Act section 14
Priority and likelihood of confusion	Trademark Act section 2(d)

Related Proceedings	Application for registration of the mark "Matchstic," serial number 85397397, denied by USPTO on the basis of confusing similarity to mark sought to be canceled.
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### Mark Cited by Petitioner as Basis for Cancellation

U.S. Application No.	85397397	Application Date	08/13/2011
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	MATCHSTIC		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 035. First use: First Use: 2003/11/01 First Use In Commerce: 2003/11/01 Brand concept and management services, namely assiting businesses in conceptualizing, identifying and creating brands, developing branding strategies, and assiting business in the creation of product and packaging designs consistent with their branding strategy
Attachments	85397397#TMSN.jpeg ( 1 page )( bytes ) Cancellation Statement Matchstick Marketing.pdf ( 2 pages )(39702 bytes )

### Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by Overnight Courier on this date.

Signature	/Brad C. Parrott/
Name	Brad C. Parrott
Date	05/07/2012

## **Matchstic, LLC Petition for Cancellation**

### **Short statement of grounds for cancellation.**

**IN RE:           Registration No. 3972323**

#### **A. Prior use and confusing similarity.**

Matchstic, LLC is an Atlanta-based marketing, branding, and design firm established in 2003 (“Matchstic”). Matchstic LLC is the owner of the trade name and service mark Matchstic. Linda Parry is listed as both Registrant and Attorney of Record for the mark “Matchstick Marketing” (the “Petitioned Mark”). The Petition Mark violates Matchstic’s earlier established property rights. This petition seeks to cancel the Petitioned Mark.

As noted above, Matchstic was founded in 2003 in Atlanta, Georgia, at which time Matchstic began to use the name “Matchstic” in commerce. Since that time, Matchstic has been involved in all stages of the branding and marketing process for its clients and has consistently held itself out as and is referred to as “Matchstic” within the industry. In August of 2011, Matchstic submitted to the United States Patent and Trademark Office (“USPTO”) an application for the registration of the service mark “Matchstic” with the following description:

“Brand concept and management services, namely assisting businesses in conceptualizing, identifying and creating brands, developing branding strategies, and assisting business in the creation of product and packaging designs consistent with their branding strategy (the “Mark”).”

The reviewing attorney at the USPTO denied Matchstic’s registration, citing the Mark’s confusing similarity to the Petitioned Mark, “Matchstick Marketing.” According to the Petitioned Mark’s registration papers, it was first used in commerce in 2008 and filed for registration with the USPTO in 2009. Thus, its use began 5 years after Matchstic.

The issuance of a Petitioned Mark’s registration by the USPTO does not extinguish the rights of prior users of similar, or even identical, marks. See, e.g., Grupo Gigante SA De CV v. Dallo & Co., Inc., 391 F.3d 1088, 1093 (9th Cir. 2004) (“Under the principle of first in time equals first in right, priority ordinarily comes with earlier use of a mark in commerce. It is ‘not enough to have invented the mark first or even to have registered it first.’”) (quoting Sengoku Works Ltd. v. RMC Int’l, Ltd., 96 F.3d 1217, 1219 (9th Cir. 1996)). Since 2003, Matchstic has established an identity as a well-known and well-respected branding-house, well before the first use of “Matchstick Marketing” in commerce. Matchstic has been featured in numerous magazine articles, has maintained a branding-focused blog since 2007, and has maintained a website under the URL <http://www.matchstic.com> since 2003. All of these items, as well as contracts entered into as far back as 2003, demonstrate Matchstic’s common law rights by prior use in the Matchstic mark dating from 2003.

## **B. Abandonment of the Petitioned Mark.**

The registered address for the Owner of the Petitioned Mark, Matchstick Marketing is a UPS Store postal box. Further, the individual owner of Matchstick Marketing, Linda Parry, has a full time job with a different marketing firm. Her current employer does not appear to use or have any interest in the Petitioned Mark. Upon review, information and belief, Matchstick Marketing is dormant and not operating. It is believed that Matchstick Marketing has been dormant for two or more years and that the Petitioned Mark has not been used in commerce in two or more years.

## **C. Damages**

Matchstic, LLC has been and will continue to be damaged both nominally and sustain actual damages if it is unable to protect its common law property rights by registration or is otherwise forced to explain or alleviate market confusion with the Petitioned Mark.

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